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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,429	08/02/2001	Lars Morch Groth	NN-6200.200 US	3993

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PATENT DEPARTMENT
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NEW YORK, NY 10036

EXAMINER

PICKETT, JOHN G

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 03/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/921,429

Applicant(s)

GROTH, LARS MORCH

Examiner

Gregory Pickett

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☒ Claim(s) 7-10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

2. The disclosure is objected to because of the following informalities: Page 8, line 25 cites "cover 6", page 9, line 1 cites "cover 6" and "cover 5is", applicant has denoted the cover as item 5 previously.

Appropriate correction is required.

Claim Objections

3. Claims 7-10 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

4. Claims 2, 4, and 6 are objected to because of the following informalities: In claim 2, "has means locking" is grammatically incorrect. In claim 4, "has means preventing" is grammatically incorrect. In claim 6, "said arms is bended forward" is grammatically incorrect. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 5 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 5, the phrase "which arms" renders the claim indefinite since it is unclear as to whether one or all of the flexible arms has a built in resiliency.

Claim 6 recites the limitations "the needle hub" in line 3, and "the ring on said needle hub" also in line 3. There is insufficient antecedent basis for these limitations in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Current (US 4,203,518).

Current discloses a needle magazine (as shown, Figures 1-2) with a cylinder-shaped base (12 and 38 assembled) having a bottom surface (bottom of 12), an upper

surface (38), a cylindrical surface (20), and compartments (18) in the form of a sector of a circle (as shown, Figure 1) and containing needle assemblies (as shown, Figure 2); a cover (24) having a first part (26), a second part (28), and a slot (34) provided in second part (28). Current functions as claimed by the applicant.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nguyen et al. (US 5,873,462) in view of Current.

Regarding claim 1, Nguyen et al discloses a needle magazine (10) with a cylinder-shaped base (30) having a bottom surface (bottom of 30), an upper surface (32), a cylindrical surface (outside wall of 30), and compartments (31) containing needle

assemblies (100); a cover (20) having a first part (top surface of 20) and a slot (21).

Nguyen et al meets all limitations claimed by the applicant except:

Nguyen et al does not disclose a cover with a second part parallel to the cylindrical surface or a slot provided on the second part.

Current discloses a cover (24) with a second part (28) parallel to a cylindrical surface (20) and a slot (34) provided on the second part (28). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the magazine of Nguyen et al by rotating the compartments and providing the magazine with a side entrance and cover as taught by Current in order to reduce the overall height of the container.

As to claim 2, the magazine of Nguyen-Current provides a means for locking each needle against rotation in splines (Nguyen et al, 44) and channels (Nguyen et al, 108).

As to claim 3, when all of the needles are used, the magazine of Nguyen-Current discloses each needle force fitted into the compartment (as shown, Figure 7).

As to claim 4, the magazine of Nguyen-Current provides a means for preventing reuse of used needle assemblies in the form of ratchet assemblies (Nguyen et al, 33 and 25) and rotational locking pins (Nguyen et al, 26 and 36).

As to claim 5, the magazine of Nguyen-Current discloses a flexible arm (Nguyen et al, 48), with a built in resiliency in its material properties, positioning the arm perpendicular to the interior surface of the compartment. The magazine of Nguyen-Current does not disclose multiple flexible arms. It would have been obvious to one of

ordinary skill in the art at the time the invention was made to break the ring of flexible arm (Nguyen et al, 48) into sections forming multiple arms in order to reduce the amount of material required to manufacture.

Further regarding claim 5, the magazine of Nguyen-Current discloses a label (Nguyen et al, 150) with the alternative design having score lines for controlled breaking of the label allowing access to the compartment (column 3, lines 57-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the score lines in an "X" pattern since it was commonly known in the art that "X" patterns efficiently effect controlled breaking. In such a case, the "X" pattern would define four flexible arms, with a built in resiliency in the score lines, holding the arms in a position perpendicular to the interior surface of the compartment.

As to claim 6, in the case of the scored label (Nguyen et al, 150), the arms of the magazine of Nguyen-Current would function as claimed by the applicant upon reinsertion of a used needle.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Messmer discloses a needle magazine with side removal. Aquino discloses a syringe magazine with force retention. Eckels, Teicher et al, and Diamond disclose resilient finger retention.

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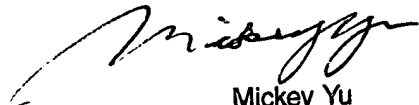
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 703-305-8321. The examiner can normally be reached on Mon-Fri, 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3579 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.



Gregory Pickett
Examiner
February 28, 2003



Mickey Yu
Supervisory Patent Examiner
Group 3700